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EXAMINER

GANTT, ALAN T

ART UNIT PAPER NUMBER

2684

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,610

Applicant(s)

OSANN, ROBERT

Examiner

Alan T. Gantt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 26-50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-25 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) 12 and 17-20 is/are objected to.
- 8) ☒ Claim(s) 26-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-25, drawn to a method of answering a call made to a mobile phone, classified in class 455, subclass 567.
- II. Claims 26-48, drawn to a wireless remote controller/communicator device, classified in class 455, subclass 419.
- III. Claims 48 and 49 drawn to a method of controlling ring indication of a mobile phone, classified in class 455, subclass 417.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method applies to the answering for any type of mobile telephone. The subcombination has separate utility such as a device for assisting in the answering of the mobile telephone utilizing a headset with controller as well as a means for defeating ringing without directly answering the phone.

During a telephone conversation with Mr. Robert Osann on 12/8/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-25. Affirmation of

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this election must be made by applicant in replying to this Office action. Claims 26-50 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims ---- are rejected under 35 U.S.C. 102(e) as being anticipated by Gusler et al.

Regarding claim 1, Gusler discloses an apparatus and method for delayed answering of mobile telephones. Thus, Gusler discloses a method for answering an incoming call made to a mobile phone, comprising:

optionally manually activating, by the receiving party, a special courtesy mode feature on the phone; (paragraphs 0022 and 0023)

playing a courtesy message to the calling party, indicating in effect that the receiving party will take their call shortly and/or that they should wait while the receiving party relocates in order to be able to better receive their call; (paragraph 0023)

having the receiving party complete their current activity and/or relocating the receiving party to a location where they are better able to receive the call and have a phone conversation with less disturbance to others around them; (paragraph 0021)

activating the phone, by the receiving party, to initiate the conversation.

(paragraph 0022)

Regarding claim 2, Gusler meets the limitation - The method of claim 1 further including the step of: observing the Caller ID display, by the receiving party, to determine whether or not to accept the call. (paragraphs 0024 and 0025)

Regarding claim 3, Gusler meets the limitation - The method of claim 1 further including the step of: placing the calling party on hold while the receiving party completes their current activity and/or relocates, the calling party remaining on hold until the receiving party activates said mobile phone to initiate the conversation or until said courtesy mode is otherwise terminated. (paragraphs 0021-0023)

Regarding claim 4, Gusler meets the limitation - The method of claim 3 further including the step of: removing the calling party from hold and sending them to voicemail, executed by the receiving party at the receiving party's discretion. (Figure 4 and paragraph 0062)

Regarding claim 5, Gusler meets the limitation - The method of claim 3 further including the step of: removing the calling party from hold and sending them to voicemail, executed

automatically after a pre-determined time-out period has elapsed since said courtesy mode was initiated, without the receiving party having activated the phone to initiate a conversation.

(Figure 4 and paragraph 0062)

Regarding claim 6, Gusler meets the limitation - The method of claim 1 further including: answering the call in the normal manner from the perspective of the mobile service provider; playing said courtesy message, provided from within said mobile phone, to the calling party; putting the calling party on hold, performed at said mobile phone. (paragraph 0050)

Regarding claim 7, Gusler meets the limitation - The method of claim 1 further including: signaling the mobile service provider from said mobile phone that the receiving party has activated courtesy mode; playing said courtesy message to the calling party, performed by the mobile service provider; placing the calling party on hold, performed by the mobile service provider; signaling the mobile service provider from said mobile phone that the receiving party desires to initiate the conversation; (paragraphs 0052 and 0056)

Regarding claim 8, Gusler meets the limitation - The method of claim 1 further including: pre-determining said courtesy message; pre-storing said courtesy message on said mobile phone. (paragraph 0050)

Regarding claim 9, Gusler meets the limitation - The method of claim 1 further including: pre-determining said courtesy message; pre-storing said courtesy message at the service provider. (paragraph 0056)

Regarding claim 10, Gusler meets the limitation - The method of claim 1 further including: synthesizing said courtesy message from a pre-determined script. (paragraph 0056)

Regarding claim 11, Gusler meets the limitation - The method of claim 1 further including: synthesizing said courtesy message according to a sequence of button presses made by the receiving party on said mobile phone. (paragraphs 0026, 0045 and 0056)

Regarding claim 13, Gusler discloses an apparatus and method for delayed answering of mobile telephones. Thus, Gusler discloses a method for answering a call made to a mobile phone, comprising:

observing the Caller ID display, by the receiving party, to determine whether or not to accept the call, and to aid in the decision of what action to take, (paragraphs 0024 and 0025)

optionally manually activating, by the receiving party, a special courtesy mode feature on said mobile phone, said courtesy mode displaying, to the receiving party, a menu of possible actions to be taken, (paragraphs 0027 and 0042)

one of which is the primary courtesy mode where a message is played to the calling party indicating in effect that the receiving party will take their call shortly and/or that they should wait while the receiving party relocates in order to be able to better receive their call; (paragraph 0021)

selecting from said menu of possible actions, by the receiving party, the action to be taken relative to answering and processing the call. (paragraph 0042)

Regarding claim 14, Gusler meets the limitation - The method of claim 13 further including, if said primary courtesy mode is chosen from said menu of possible actions: placing the calling party on hold; having the receiving party complete their current activity and/or relocating the receiving party to a location where they are better able to receive the call and have a phone conversation with less disturbance to others around them; activating said mobile phone, by the receiving party, to initiate the conversation. (paragraph 0021-0024)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gusler et al., in view of Yamashita.

Regarding claim 16, Gusler discloses an apparatus and method for delayed answering of mobile telephones. Thus, Gusler discloses a method for answering a call made to a mobile phone, comprising:

observing the Caller ID display, by the receiving party, to determine whether or not to accept an incoming call, and to aid in the decision of what action to take in processing the call; (paragraphs 0024 and 0025)

Gusler does not explicitly state pressing a sequence of numerical buttons that is interpreted according to the function key that is subsequently pressed.

Yamashita discloses a portable communication apparatus that can stop the alerting of the occurrence of an incoming call while also holding the incoming call. A silence function is assigned to at least one key for an alert operation mode. A response function is assigned to at least one of the plurality of keys for an alert stopped mode. The response to the incoming call held is performed when a key having the response function assigned to it is operated.

Yamashita meets the limitation:

optionally pressing a sequence of numerical buttons on said mobile phone, by the receiving party, the function to be initiated by said sequence of numerical button presses to be interpreted according to what function key is subsequently pressed; (col. 4, line 53 – col. 5, line 13)

optionally pressing a function key on said mobile phone, the action initiated by said function key being influenced by said previously entered sequence of numerical button presses, and determining how said incoming call is to be answered and

processed. (col. 5, lines 15-39)

Gusler and Yamashita are combinable because they share a common endeavor, namely mobile telephone devices that can alter the normal reception of a telephone call. At the time of the applicant's invention it would have been obvious to modify Gusler to include means for interpreting a sequence of numerical button presses on the telephone's keypad to cause a function button to have an instant meaning as done by Yamashita so that the required number of keys on a mobile device is reduced.

Regarding claim 15, the examiner takes Official Notice that it is well known to initiate a display and at the same time selecting a mode of action as a default mode and that it would have been obvious to modify the Gusler / Yamashita combination to include such action as it is a time saving tool since the most common action is used as a default action.

Allowable Subject Matter

Claims 21-25 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 21, the pressing of one or two function buttons on a mobile telephone that initiates an action that is influenced by a previously entered sequence of numeric button presses that starts either a courtesy mode message or voicemail was neither found, suggested, nor made evident by the prior art.

Claims 12 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 12, the including in the courtesy message of an approximate waiting time the caller will have to wait until the receiving party will initiate the conversation, where the waiting time is determined by a sequence of button presses was neither found, suggested, nor made evident by the prior art.

Regarding claim 17, the period of waiting time indicated in a courtesy mode message being defined by previously entered sequence of numerical button presses of a mobile telephone was neither found, suggested, nor made evident by the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Himmel et al. discloses an apparatus and method for managing a mobile phone answering mode and outgoing message based on a location of the mobile phone.


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Any inquiry concerning this communication from the examiner should be addressed to Alan Gantt at telephone number (703) 305-0077. The examiner can normally be reached between 9:30 AM and 6 PM within the Eastern Time Zone. The group FAX number is (703) 872-9306.

Any inquiry of a general nature or relating to this application should be directed to the group receptionist at telephone number (703) 305-4700.

Alan T. Gantt

April 16, 2005



NICK CORSARO
PRIMARY EXAMINER